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APPLICATION NO. 09/203,645	FILING DATE 04/01/99	FIRST NAMED INVENTOR KHETANI	ATTORNEY DOCKET NO. CELG-0119
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HM12/1013

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EXAMINER CHANG, C
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ART UNIT 1625	PAPER NUMBER
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DATE MAILED: 10/13/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

**Advisory Action**Application No.  
**09/283,645**Applicant(s)  
**Khetani et al.**Examiner  
**Celia Chang**Group Art Unit  
**1625**

## THE PERIOD FOR RESPONSE: [check only a) or b)]

- a) ☒ expires 3 months from the mailing date of the final rejection.
- b) ☐ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☐ Appellant's Brief is due two months from the date of the Notice of Appeal filed on \_\_\_\_\_ (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on Sep 27, 2000 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

☒ The proposed amendment(s):

- ☒ will be entered upon filing of a Notice of Appeal and an Appeal Brief.
- ☐ will not be entered because:
- ☐ they raise new issues that would require further consideration and/or search. (See note below).
  - ☐ they raise the issue of new matter. (See note below).
  - ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
  - ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

- ☐ Applicant's response has overcome the following rejection(s): \_\_\_\_\_

- ☐ Newly proposed or amended claims \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.
- ☒ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See attachment to advisory.

- ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

- ☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: none

Claims objected to: \_\_\_\_\_

Claims rejected: 1-8 and 10-13

- ☐ The proposed drawing correction filed on \_\_\_\_\_ ☐ has ☐ has not been approved by the Examiner.
- ☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Other

*Celia Chang*  
**CELIA CHANG**  
**PRIMARY EXAMINER**  
**GROUP 1200/625**

Art Unit: 1625

### Attachment to Advisory

The request for reconsideration and arguments filed in paper No.6, dated September 27, 2000 have been considered carefully but are deemed to be not persuasive.

Applicants argued that the rejections of claims 1-8, 10, 11 and 13 under 35 U.S.C. 103(a) over Jursic in view of Berrang, Ohashi and Vanderplas or further in view of Feng or Patrick, failed to provide ".....'evidence of [a] motivating force that would impel one skill in the art' to substituted the chiral agents of the Jursic .....through their ability to form  $\pi$ - $\pi$  aromatic stacking and hydrogen bonding" (see p. 2 response).

It is noted that in claim 1, the "resolving" agent is an "acid resolving agent". It is also noted that the Jursic reference, on page 1713, line 1, the resolving agents are operable based on the "acidity of the amide hydrogen". Attorney's attempt to misleading the interpretation of this acidic resolving agent by alleging it being hydrogen bonding is erroneous. The Hack's chemical dictionary is hereby provided for attorney's convenience. Please note that an "acid" is not limited to compounds having -COOH moieties. Definition of acid includes proton donor such as the amides of Jursic.

It has been clearly delineated in the rejection that Jursic employed "chiral resolving agents" to resolve diastereomers of the claimed piperidinyl acetamide, thus, obtained the d-threo form of piperidinyl acetamide. Berrang, Ohashi, Vanderplas, Feng or Patrick indicated alternative "chiral resolving agents" suitable for amides such as tartaric acid were successful in structurally close compounds, therefore, are expected to be operable especially under the motivation that pieridinyl amide tartrates are easily separable by fractional crystallization.